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EXAMINER
CHRISTENSEN, SCOTT B

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/582,129	KERDRAON ET AL.
	Examiner	Art Unit	
	Scott Christensen	2144	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 June 2008</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-15</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-15</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>08 June 2006</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/8/2008</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in regard to the most recent papers filed on 6/8/2006.

Claim Objections

2.   Claim 2 is objected to because of the following informality: Claim 2 makes

reference to an "event notification modet." This is apparently a typo and should read

"event notification mode." Appropriate correction is required.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regard as his invention.

4.   Claims 4, 12, 13, and 15 are rejected under 35 U.S.C. 112, second paragraph,

as being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regard as the invention.

        With regard to claim 4, the instant claim states "wherein the connectibility state

not available or to the service determined by the service mediation server can be in one

of the following states." This phrase does not make sense. It appears that this should

be referring to a previously recited step, and is thus interpreted for the purposes of

prosecution to refer to "the service media server determines a state of connectability of

each user," as in claim 1. Further, the presented list is interpreted as being possible

states of connectability. The instant claim should be amended to recite clearly what

Applicant regards as his invention.

With regard to claim 12, the instant claim states "…telecommunication networks, to program include instructions…" This phrase does not make sense. It appears that this is intended to state that the program includes instructions, and will be assumed for purposes of prosecution.

With regard to claim 13, claim 13 includes means for connecting to the service mediation server according to claim 7. However, claims 7 is directed towards the service mediation server, not towards the means for connecting to the service mediation server. For purposes of prosecution, it will be assumed that claim 13 states "means for connecting to the service mediation server."

Claim 15 includes the phrase "wherein the service mediation server is consistent with one of claim 7." First, the instant claim should be amended to simply recite, "with claim 7." Second, the term "consistent" renders this claim indefinite, as it is unclear to what degree "consistent" requires the limitations of claim 7. "Consistent" could either require all the limitations, or simply a server, as a server is "consistent" with any other server, or anything in between.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6.   Claims 7-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With regard to claim 7, the instant claim is directed towards a server for mediation of telecommunication services. However, the server for mediation according to the specification page 22, lines 11-16, is apparently a program to be implemented on another server. Thus, the server for mediation of telecommunication services is apparently software per se. Software per se is nonstatutory. For a system claim to be found statutory, the claim must only include embodiments that are directed towards hardware or a combination of hardware and software, but the claim must have no embodiments that are directed towards software alone. Claims 8-11, and 13, depending from claim 7, are rejected for the same.

With regard to claims 12 and 14, both claims are directed towards computer programs. As stated with regard to claim 7, claims directed towards software per se are nonstatutory.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8.   Claims 1, 3-5, 12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Day, Rosenberg and Sugano in RFC 2778, "A Model for Presence and Instant Messaging" from February 2000, hereafter referred to as "RFC2778."

With regard to claim 1, RFC2778 discloses a method for coordinating telecommunication services provided to a plurality of users, by means of communications terminals connected to various telecommunications networks, wherein a service mediation server coordinates the processing operations performed by various telecommunication services on behalf of each of the users including steps wherein:

the telecommunication services connected to the service mediation server and specify events of which they must be notified by the service mediation server, and/or events that they are capable of transmitting to the service mediation server (RFC2778: Page 3, Figure 1 and Page 1, section 1. The Watchers can subscribe to be informed of the presence of a presentity. The action of subscribing specifies that the watcher wishes to be informed of any changes in state.),

the telecommunications terminals of the users connect to the service mediation server and transmit to the server mediation server user profiles specifying availability modes, which are stored in a database and, activate profiles and previously specified availability modes, and access the connected services (RFC2778: Page 4, step 3b; page 9, access rules, page 6, and Page 12, presentity. The presentity connects to the presence server to declare the status of the presence server. Information of the presentity is stored in a "Presence Tuple" at the presence server.),

the service mediation server determines a state of connectability of each user on the basis of existence of at least one user terminal connected to the server, and the user's active availability mode and profile (RFC2778: Page 2, Section 2.1),

the service mediation server transmits to each connected terminal the state of connectability of users specified in a list of contacts forming part of the active profile of the terminal user (RFC2778: Page 3 and Page 9, section 2.7. The terminal is notified of the status of any presentities that the terminal subscribed to.), and

the service mediation server transmits, for each event received from a service, an event notification to the connected services having specified that they must be notified of the event (RFC2778: Page 3, Figure 1, and page 1, section 1. The services that subscribed to a presentity is notified of the presentity's status when the status changes.).

With regard to claim 3, RFC2778 teaches that each availability mode specified by a user also includes availability rules specifying periods in which the availability mode is active (RFC2778: Page 9, "ACCESS RULES").

With regard to claim 4, RFC2778 discloses that the connectability state not available or to the service determined by the mediation server can be in one of the following states:

connectable if the active availability mode for the user is in the available state and if at least one user terminal is connected to the service mediation server (RFC2778: Page 5, Section 2.4. If the user is connected to the mediation server (presence server), and the user is reported as online, the user is connectible. Further, to anticipate the

instant claim, only one of the states needs to be disclosed, as the claim states, "the connectability state"..."can be in **one** of the following states."),

not connectible if no user is connected to the mediation server (RFC2778: Page 5, section 2.4),

access to the connectability state subject to authorisation if the user wants his/her connectability state to be provided to other users only with his/her prior authorisation,

in transfer if the user specified that incoming calls intended for him/her must be transferred to a call number specified in the active availability mode (RFC2778: Page 5, section 2.4. It is noted that the "call number" does not have to be different than the standard call number of the user. Thus, the online state meets this limitation.),

unknown if the requested user is not registered with the service mediation server or if he/she does not want his/her connectability state to be accessible.

With regard to claim 5, RFC2778 discloses that the transmission of event notifications by the service mediation server is carried out upon request of each connected service (RFC2778: Page 3. The presentities and watchers have to connect to the presence server, and the watchers have to request the information.).

With regard to claim 12, the instant claim is substantially similar to claim 1, and is rejected for substantially similar reasons.

With regard to claim 14, the instant claim is substantially similar to claim 1, and is rejected for substantially similar reasons.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims 2, 6, 7-11, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over RFC2778.

With regard to claim 2, RFC2778 discloses that each availability mode specified by a user includes:

an availability state capable of having the values of available, not available, in call transfer to a specified call number (RFC2778: Page 5, Section 2.4. "in call transfer to a specified call number," as claimed, does not require that the number is a different number than the user's normal number. Thus, the user's regular number, and thus "available" is equivalent to "in call transfer to a specified call number," as the presence is with respect to a "specific call number," and any call that is made is transferred to the destination.),

an optional terminal identifier to which an incoming call intended for the user is transferred (RFC2778: Page 5, Section 2.4. First, the term "optional" means that this

limitation is not required to anticipate or teach the instant claim. Second, the call is transferred to the user's contact address.),

an event notification mode (RFC2778: Page 14, watcher and watcher information).

RFC2778 does not appear to disclose expressly:

an availability list capable of having the values of an unknown number if the user does not want his/her availability state to be accessible, and

a list of contacts to which the availability state applies.

However, Official Notice (see MPEP 2144.03) is taken that a person of ordinary skill in the art would have known how to allow the user to be "invisible" to other users (an availability list capable of having the values of an unknown number if the user does not want his/her availability state to be accessible) and have different availabilities for different contacts (a list of contacts to which the availability state applies).

Thus, it would have been obvious to have: an availability list capable of having the values of an unknown number if the user does not want his/her availability state to be accessible, and a list of contacts to which the availability state applies in the disclosure of RFC2778.

The suggestion/motivation for doing so would have been that many user's prefer to have some control over their settings to allow for privacy. Thus, a user may wish to be "invisible," thus not allowing the user's state to be known, or have different states for different users. The different states for different users allows some other users to essentially be blocked, where the user does not wish to be contacted by the other

users, yet desirable users would still see the user as being available. It is noted that some collaboration tools on the market already perform this functionality, such as AOL Instant Messenger, where users may be blocked (thus reporting the user of the system as being unavailable), or allows the user to be invisible (which allows the user to be online without the user's status being known to others).

With regard to claim 6, RFC2778 discloses that the transmission of an event notification by the service mediation server is performed upon receipt of the event if the service is connected (RFC2778: Page 3, Figure 1. However, RFC2778 does not appear to disclose expressly that otherwise, the event is stored in a log and is notified to the service when the latter connects to the service mediation server.

However, Official Notice is taken a person of ordinary skill in the art would have known how to store a message for a user when the user is not connected for later delivery.

Thus, it would have been obvious to have the event is stored in a log and is notified to the service when the latter connects to the service mediation server.

The suggestion/motivation for doing so would have been that even notifications intended for the service can be delivered to the service when the service is temporarily disabled.

With regard to claim 7, the instant claim includes subject matter that is substantially similar to subject matter presented in claims 1-6, and is rejected for substantially similar reasons.

With regard to claim 8, RFC2778 teaches an authentication/identification module responsible for identifying and authenticating the users when the access the service mediation server or certain services (RFC2778: Page 6. The users are at least identified by the presence tuple.).

With regard to claim 9, RFC2778 teaches an interface module for providing access to the service mediation server by means of a telecommunications network, which module is designed to receive process requests, from services or users, and to retransmit them to a component of the server responsible for performing the requested processing operation, and transmitting, in response to these requests, the responses provided by the components of the server (Page 8, Figures 6 and 7. The presence service is connected via a network to the presentity and watcher.).

With regard to claim 10, RFC2778 teaches the invention as substantially claimed except that the interface module comprises a plurality of duplicate components so as to ensure fault tolerance.

However, Official Notice is taken that is was very well known to provide duplicate components for fault tolerance.

Thus, it would have been obvious to provide duplicate components for fault tolerance in the disclosure of RFC2778.

The suggestion/motivation for doing so would have been that providing duplicate components allows the system to remain operational even if a component fails. For example, if multihoming were utilized, then multiple connections to the Internet would be utilized. In case one of the connections fail, the other connections would be available to take over. Thus, the system would remain operational.

With regard to claim 11, RFC2778 teaches an access monitor including:

means for connecting a user terminal to the mediation server and disconnecting it from the server (RFC2778: Page 3 and page 8. The user can connect their terminal to the mediation server and disconnect it.),

means for connecting a service to the mediation server and disconnecting it from the server (RFC2778: Page 3, page 8. The user can connect to the mediation server as a watcher.),

means for selecting a profile to be activated and an availability mode in the profile to be activated, means for selecting events of which the user wants to be notified of the appearance (RFC2778: Section 2.1. The presentities report their status to the server, and provides the information included in the presence tuple on page 6.), and

means for selecting a terminal to receive an incoming call (RFC2778: Page 6, contact address).

However, RFC2778 does not appear to disclose expressly:

means for managing, in real time, the various services activated for the user.

However, RFC2778 does appear to be intended to be implemented on computer systems. It is noted that a computer system manages, in real time, applications and services that are being used by a user.

Thus, it would have been obvious to have means for managing, in real time, the various services activated for the user in the disclosure of RFC2778.

The suggestion/motivation for doing so would have been that managing services in real time on a user's computer system allows the computer system to be responsive to changing conditions in the services, and thus allows the computer to execute the services in an efficient manner.

With regard to claim 13, the instant claim is substantially similar to claim 7, and is rejected for substantially similar reasons.

With regard to claim 15, the instant claim is substantially similar to claim 7, and is rejected for substantially similar reasons.

Citation of Pertinent Art

11.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 2003/0009530 to Philonenko et al.;

US 2004/0064514 to Daniell et al.; and

US 2005/0071428 to Khakoo et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Christensen whose telephone number is (571)270-1144. The examiner can normally be reached on Monday through Thursday 6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul H Kang/
Primary Examiner, Art Unit 2144

/S. C./
Examiner, Art Unit 2144